# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/835,301 | 04/13/2001 | Patrick Fitzpatrick | 50P3987.01 | 4748 |

| 7590 | 05/20/2004 |
|---|---|

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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2124 | |

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C  (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/835,301 | FITZPATRICK, PATRICK |
| | Examiner | Art Unit |
| | Insun Kang | 2124 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 April 2001 and 17 September 2001*.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-39* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1. This action is responding to application papers dated 4/13/2001 and 9/17/2001.

2. Claims 1-39 are pending in the application.

### *Claim Rejections - 35 USC § 112*

3.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.      Claims 2- 8, 10, 16-22, 24, 30-36 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 16 and 30 recite the limitation "the units." There is insufficient antecedent basis for this limitation in the claims. It is interpreted as "the plurality of remote units."

Claims 3, 17 and 31 recite the limitation "the at least one unit" in the claims. There is insufficient antecedent basis for this limitation in the claims. It is interpreted as "the at least one remote unit."

Claims 4, 18 and 32 recite the limitation "the plurality of paths" in the claims. There is insufficient antecedent basis for this limitation in the claims.

Claims 8, 22 and 36 recite the limitation "the at least one unit" in the last line. There is insufficient antecedent basis for this limitation in the claims.

As per claims 5, 6, 7, 10, 19-20, 21, 24, 33-35 and 38, these claims are rejected for dependency on the above rejected parent claims 4, 8, 18, 22, 32 and 36.

## *Claim Rejections - 35 USC § 102*

5.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

6.      Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by

MacInnis (US Patent 5,951,639).


Per claim1:

MacInnis discloses:

- downloading code to at least one remote unit on a network having a plurality of remote

units wherein there are a plurality of data paths for transmitting code to each remote unit

("selectively downloading software and data modules to terminals in a network... Each

terminal receives the transmitted descriptors ... [t] actual module may be downloaded in

a "carousel" channel which continuously broadcasts all the various versions of modules

in a loop," col 2 lines 17-42)

-selecting one of the plurality of data paths based on the code to be transmitted ("Each

terminal extracts the descriptor table and , based on a match between an entry in the

descriptor table and an internally stored table determines which version of a particular

module should be downloaded," abstract)

-transmitting the code to the at least one remote unit on the selected data path ("The

actual downloading procedure may be accomplished by selectively extracting the

module from a separate channel on which transmitting source continuously broadcasts

all versions of all the modules in a loop," col 4 lines 20-40)

 as claimed.


Per claim 2:

The rejection of claim 1 is incorporated, and further, MacInnis discloses

that the units are set top boxes ("home communication terminal," col 3 lines 10-27) as

claimed.


Per claim 3:

The rejection of claim 1 is incorporated, and further, MacInnis discloses

that the code is software code used to update the software running on the at least one

unit ("a updated software," col 1 lines 50-65; "automatically find the most recent version

of the operating system to be downloaded for the terminal," col 2 lines 43-46) as

claimed.


Per claim 4:

The rejection of claim 3 is incorporated, and further, MacInnis discloses

that at least one path of the plurality of paths has a different data rate loss than the

other paths of the plurality of data paths ("transmitting soure...to a plurality of

terminals...selects the "best" module version for that terminal," col 2 lines 30-42) as

claimed.


Per claim 5:

The rejection of claim 4 is incorporated, and further, MacInnis discloses:

-selecting one of the plurality of data paths based on the code to be transmitted and the

data rate loss of the path ("transmitting soure...to a plurality of terminals...selects the

"best" module version for that terminal...in a "carousel" channel," col 2 lines 30-42) as

claimed.


Per claim 6:

The rejection of claim 4 is incorporated, and further, MacInnis discloses

- selecting one of the plurality of data paths having the lowest data rate

loss("transmitting soure...to a plurality of terminals...selects the "best" module version

for that terminal...in a "carousel" channel," col 2 lines 30-42) as claimed.

Per claim 7:

The rejection of claim 4 is incorporated, and further, MacInnis discloses

-selecting one of the plurality of data paths having the lowest data rate loss when the

code represents critical software for the at least one unit (col 6 lines 13-25; col 2 lines

30-42) as claimed.

Per claim 8:

The rejection of claim 4 is incorporated, and further, MacInnis discloses

- selecting one of the plurality of data paths having the lowest data rate loss where the

code represents critical software stored in non-erasable memory of the at least one unit

("Instructions to execute... could be installed into ROM to prevent erasure or corruption,"

col 7 lines 55-61) as claimed.

Per claim 9:

The rejection of claim 1 is incorporated, and further, MacInnis discloses

- transmitting the code to the plurality of remote units in a descriptor file that indicates

the at least one remote unit is recipient of the code ("Each terminal extracts the

descriptor table and, based on a match between an entry in the descriptor table and an

internally stored table determines which of a particular module should be downloaded,"

abstract) as claimed.

Per claim 10:

The rejection of claim 8 is incorporated, and further, MacInnis discloses

- transmitting a descriptor file to the plurality of units that indicates at least one remote

unit is to receive the code; and transmitting the code to all remote units ("downloading

source transmits the descriptor table to each terminal and also continuously transmits

the modules over the network," abstract) as claimed.

Per claim 11:

The rejection of claim 1 is incorporated, and further, MacInnis discloses

- separating the code into a plurality of modules, transmitting a descriptor file to the

plurality of units that indicates at least one remote unit is to receive the code and the

code is separated into a plurality of modules; and transmitting the plurality of modules to

the plurality of remote units. ("downloading source transmits the descriptor table to each

terminal and also continuously transmits the modules over the network," abstract);

Per claim 12:

The rejection of claim 11 is incorporated, and further, MacInnis discloses

-each remote unit receiving the descriptor file ("Each terminal receives the transmitted

descriptors," col 2 lines 30-42)

- each remote unit retrieving the modules identified by the descriptor file when the

descriptor file indicates the remote unit is to receive the modules ("Each of the actual

modules is preferably assocated with a module identifier in table T, which is in turn

associated with module descriptors," col 5 lines 1-7) as claimed.

Per claim 13:

The rejection of claim 11 is incorporated, and further, MacInnis discloses

- each remote unit receiving the descriptor file("Each terminal receives the transmitted

descriptors," col 2 lines 30-42)

- each remote unit retrieving the modules identified by the descriptor file and assembling

the modules into the code when the descriptor file indicates the remote unit is to receive

the modules ("Each of the actual modules is preferably assocated with a module

identifier in table T, which is in turn associated with module descriptors," col 5 lines 1-7)

as claimed.

Per claim 14:

The rejection of claim 11 is incorporated, and further, MacInnis discloses

- each remote unit receiving the descriptor file("Each terminal receives the transmitted

descriptors," col 2 lines 30-42)

-each remote unit retrieving the modules identified by the descriptor file("Each of the

actual modules is preferably assocated with a module identifier in table T, which is in

turn associated with module descriptors," col 5 lines 1-7)

- assembling the modules into the code, and installing the code when the descriptor file

indicates the remote unit is to receive the modules("Instructions to execute... could be

installed into ROM to prevent erasure or corruption," col 7 lines 55-61) as claimed.

Per claims 15-28, they are the article of manufacture versions of claims 1-14,

respectively, and are rejected for the same reasons set forth in connection with the

rejection of claims 1-14 above.

Per claims 29-39, they are the apparatus versions of claims 1-11, respectively, and are

rejected for the same reasons set forth in connection with the rejection of claims 1-11

above.

7.      Claims 1 are rejected under 35 U.S.C. 102(e) as being anticipated by Gazda et

al. (US Patent 6,453,470) hereinafter referred to as "Gazda."

Per claim 1:

Gazda discloses:

- downloading code to at least one remote unit on a network having a plurality of remote units wherein there are a plurality of data paths for transmitting code to each remote unit comprising selecting one of the plurality of data paths based on the code to be transmitted and transmitting the code to the at least one remote unit on the selected data path ("An executable software path is selected from a plurality of available executable software paths according to the identifying information... the selected executable software path is executed at a processor of the terminal to initialize the hardware component," col 2lines 25-34) as claimed.

Per claim 15, it is the article of manufacture version of claim 1, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 1 above.
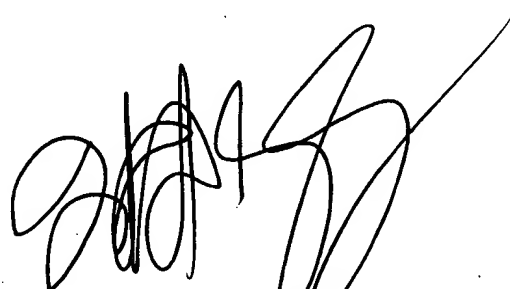
Per claim 29, it is the apparatus version of claim 1, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 1 above.

8.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 703-305-6465. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on 703-305-9662. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free).

IK
5/12/2004

TODD INGBERG
PRIMARY EXAMINER